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Attorney Docket No.: GVC.00001US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit:	1794	)	
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Examiner:	Patricia L. Nordmeyer	)	<b>FILED VIA EFS</b>
		)	
Inventor(s):	James E. Staargaard	)	Confirmation No.: 3459
		)	
Serial No.	10/627,910	)	
		)	
Filed:	July 25, 2003	)	
		)	<b>CORRECTED</b>
		)	<b>APPEAL BRIEF</b>
Title:	METHOD OF ATTACHING PLASTIC TO A	)	
	METAL SECTION AND PART MADE	)	
	THEREBY	)	
		)	

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Sir:

On November 14, 2008, the Appellants filed a Notice of Appeal of a Final Rejection in the Final Office Action mailed July 14, 2008. This appeal covers claims 22, 24, 26 and 29-33.

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**I. REAL PARTY IN INTEREST**

The real parties in interest are SABIC Innovative Plastics IP B.V. and Vari-Form.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other related appeals or interferences.

**III. STATUS OF THE CLAIMS**

Claims 22, 24, 26 and 29-33 are pending and have been rejected.

Claims 1-21, 23, 25, and 27-28 were previously canceled.

Claims 22, 24, 26 and 29-33 are on appeal.

There are no other claims.

**IV. STATUS OF THE AMENDMENTS**

On May 19, 2008, the Appellants filed a Response to Non-Final Office Action. In that amendment, Appellants argued for the allowance of claims 22, 24, 26 and 29-33. Subsequently, on July 14, 2008, a Final Office Action was issued rejecting the pending claims. On November 14, 2008 Appellants filed its Notice of Appeal from the Final Office Action. Each issue raised in the Final Office Action needs to be considered by the Board. The attached claims reflect those in the application considered in the Final Office Action. There are no amendments subsequent to the Final Office Action.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

**A. INDEPENDENT CLAIM 22**

Independent claim 22 recites and integral plastic and metal component. *Page 4, ¶17.* The metal component has a closed cross-section defining an interior and exterior. *Page 4, ¶18; Pages 5-6, ¶23.* The first opening defines edges. *Page 6, ¶23.* The metal component further has a second opening opposite the first opening for allowing a core tool to be inserted into the

interior of the metal component during a molding operation. *Pages 5-6, ¶¶23-24; Page 8, ¶¶29-30.* The part further comprises a plastic component disposed about at least a portion of the exterior of the metal component. *Pages 4-5, ¶¶20-22; Page 6, ¶25; Page 7, ¶26.* A portion of the plastic material is disposed through the first opening. *Pages 6-7, ¶25; Page 7, ¶26.* The plastic component includes a flange extending beyond the edges of the first opening and into the interior of the metal component for securing the plastic component to the metal component and not covering the second component. *Pages 6-7, ¶¶25-26; Pages 5-6, ¶23; Page 7, ¶28; Page 8, ¶30.* The plastic component includes at least one integrally formed connection member extending outwardly therefrom. *Page 5, ¶¶21-22; Page 6, ¶25.* The at least one connection member has an area defining at least one connection portion formed thereon, wherein the at least one connection portion is operable to receive a fastening member so as to permit the plastic component to be fastened to at least one other component. *Page 5, ¶¶21-22; Page 6, ¶25.*

## **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Whether claims 22, 24, 26 and 29-33 are unpatentable under 35 U.S.C. §103(a) as being obvious over United States Patent No. 3,470,598 to Berthelsen in view of United States Patent No. 5,634,306 to Riegelman.

## **VII. ARGUMENT**

- A. **CLAIM 22 IS NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) AS BEING OBVIOUS OVER BERTHELSEN IN VIEW OF RIEGELMAN.**

The Appellants contend that a prima facie case of obviousness has not been established for claim 22 over Berthelsen in view of Riegelman for the reasons set forth below. The Appellants therefore respectfully request that the Board reverse the Final Office Action's rejection based on 35 U.S.C. §103(a) as being unsupported.

# **1. The Final Office Action Is Incomprehensible**

The Final Office Action indicates that Berthelsen discloses an integral plastic and metal part comprising a metal component (Fig. 1,  $O_R$ ) in having a first opening defining edges (Fig. 1, holes on one side of the casing) and second opening opposite the first opening (Fig. 1, the folded edge on the part labeled  $O_R$ ). But then the Final Office Action indicates that Berthelsen discloses a second opening as defined by a second edge in the metal component, said second edge being folded (Fig. 3,  $E_3$ ) wherein the second opening is the opened end of the U. But, this statement applying an opening to be the opened shape of the U of component  $E_3$  in Figure 3 is inconsistent with the earlier statement in the Final Office Action that indicates that the second opening is the folded edge on the part labeled  $O_R$ . The Final Office Action thus, cites two separate and different components,  $O_R$  and the metallic component contained in  $E_3$ , to constitute second openings of the metallic component. It simply cannot be reconciled how the second opening can be on both  $O_R$  and  $E_3$  when these are separate parts.

Further, the Final Office Action refers to component  $E_3$  in connection with Figure 3. However, Figure 3 does not contain any component  $E_3$ . This error was pointed out to the PTO in response to an earlier Office Action. Rather than correct the error such that Applicants could formulate a response, the Final Office Action simply repeats the earlier rejection, error and all. Figure 3 is a perspective view illustrating a further stage of processing of the metal strip. The metal strip shown in Figure 3 is labeled "part 12" which corresponds to the metal component in  $E_2$  (See, Figure 1). The component  $E_3$  is shown only in Figures 1 and 13 in which  $E_3$  is designed to form a stationary part of a structural element. The component  $E_3$  appears to include a U-shaped metal element that is fully encapsulated in plastic, and not a metal component having a closed cross-section. To the extent the Final Office Action applies Berthelsen in such a manner that the second opening is the open end of the U, it is inconsistent with the remainder

of the Final Office Action that indicates that Berthelsen's second opening is the folded edge on the part labeled  $O_R$  as set forth above. Accordingly, the Final Office Action cites two separate parts defining the second opening. This inconsistency alone precludes any finding of obviousness based on 35 U.S.C. §103 because the Final Office Action fails to clearly articulate any rejection based on the cited reference.

## **2. The First Rejection Based On Berthelsen**

Appellants here are placed in a disadvantageous situation. As set forth above, the Final Office Action plainly is in error. This was pointed out to the PTO in response to previous Office Actions. This leaves Appellants to guess as to how Berthelsen is being applied as the primary reference supporting the §103 rejection. The argument below is based on Appellants' best attempt to discern the basis for the Final Office Action. While the Final Office Action does not specifically break the rejection down into two separate applications of the Berthelsen reference, as set forth above, as a practical matter that appears to be what has occurred. While not so specifically stated in the Final Office Action, Appellants will attempt to address each of these different, and mutually exclusive, rejections herein.

In the first statement of the Final Office Action, Berthelsen is said to have first openings defining edges on one side of the casing and second openings, opposite the first opening (Figure 1, the folded edge on the part labeled  $O_R$ ). First, it is respectfully submitted that the part  $O_R$  is not a closed cross-section as required by claim 1. This is identified in the Final Office Action at 3, "However, Berthelsen fails to disclose having a closed cross section defining an interior and exterior."

Second, the part  $O_R$ , is apparently being applied only insofar as the portion that is folded over (not labeled). Claim 22 requires that the first opening be opposite the second opening. However, in the cited application, there is no indication the any first opening (those on one side

of the fold) are opposed to second openings (those on the opposite side of the fold). Indeed, from Figure 1, all that can be noted is that the openings are on opposite sides of the folded over portion, but these openings appear offset from one another.

Paragraph 24 of the Specification shows that openings as claimed herein are opposite or opposed from one another. Accordingly, the Berthelsen reference as applied also fails to show this limitation of claim 22. The claimed language provides a structural difference over Berthelsen. The openings being opposite from one another allows a core tool to be inserted into the interior of the metal component during a molding operation. Such structure is lacking in Berthelsen.

Further, the Berthelsen reference, as applied, clearly indicates that this “second opening”, as applied in the Final Office Action, is completely embedded within the plastic material and not open. See, e.g., col. 1, lines 32-36; Figures 1 and 13; col. 3, lines 54-57 and 69-72. Again, this is different from the claimed structure. Instead, the Final Office Action erroneously relies on *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed.Cir.1993) for the proposition that claim features which Applicants rely (i.e., that the second opening is not covered) on in arguments not recited in the rejected claims will not be read into the claims.

The Riegelman reference is relied upon to show a closed section metallic component. However, Riegelman fails to make up for the other deficiencies of Berthelsen. Specifically, the Final Office Action fails to indicate how Riegelman shows opposed openings as recited in the claims. Further, the Final Office Action fails to demonstrate any particular reason why one of ordinary skill in the art would use a closed cross-section as set forth in Riegelman as a substitute for the open cross-section  $O_R$  of the Berthelsen reference. In any event, the combination plainly shows that one of ordinary skill in the art would not look to the combination. That is, the Riegelman reference, in particularly Figures 41 and 42, show an application of a

closed cross-section. No opposed openings are shown in Riegelman. Furthermore, the Riegelman reference shows that in a closed cross-section, every opening is filled with plastic material. Accordingly, Riegelman fails to cure the deficiencies of Berthelsen.

The absence of either of the references to singularly or collectively disclose each of the claimed features indicates that the rejection based on 35 U.S.C. §103 cannot stand. This is because, even combining the references as sought by the Final Office Action does not result in the claimed invention.

### **3. The Second Application Of Berthelsen**

In the second application of the Berthelsen reference, the Final Office Action refers to Figure 3, component E<sub>3</sub> to show a second opening. As set forth above, Figure 3 does not include a component E<sub>3</sub>. This was pointed out to the PTO which in the Final Office Action maintains an erroneous objection and fails to clarify what it meant. Component E<sub>3</sub> is found only in Figures 1 and 13. The Final Office Action lacks clarity because it requires the Applicants to guess as to what forms the basis of the rejections. This is improper. Simply put, Appellants have no idea what component E<sub>3</sub> is in Figure 3. As a result, no response can be made because the Final Office Action fails to meet its burden of establishing an obviousness rejection.

### **B. THE REJECTION TO CLAIM 31 IS INAPPROPRIATE**

The Final Office Action inappropriately rejects claim 31. The Final Office Action indicates that the second edges in the metal component are folded and references Figure 1, the folded edge on the part labeled O<sub>R</sub>. But no edges of any second opening are folded as claimed. In a glaring inconsistency with the application of Berthelsen to claim 29, the Final Office Action never refers to the edges of the first holes as being folded and instead refers to them as being curved. But now, in connection with claim 29, the Final Office Action indicates that “second



holes” having the same shape as the “first holes” have edges that are “curved” are now not curved, but folded. Respectfully, the edges of the second opening are not “folded” as claimed, and the §103 rejection is not proper.

**C. THERE IS NO ARTICULATED REASON IN THE FINAL OFFICE ACTION FOR A FINDING OF OBVIOUSNESS**

With respect to each of the combinations set forth in the Final Office Action, the Final Office Action fails to clearly articulate a reason as to why a person of ordinary skill in the art would find the claimed invention obvious. The absence of such a clearly articulated reason including a rational underpinning negates any finding of obviousness. See, *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1896 (2007). The only statement with regard to obviousness in the Final Office Action is the conclusion:

It would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have provided a closed cross section defining an interior and exterior in Berthelsen in order to contribute strength to each of the members of the composite as taught by Riegelman.

There is no specific explanation from this statement as to why a skilled artisan would combine the teachings of Berthelsen and Riegelman. This is particularly problematic in this case where the Final Office Action makes to separate and different rejections based on Berthelsen, failing to adequately delineate how the reference is being applied.

**VIII. CONCLUSION**

The Board should reverse the rejections to each of claims 22, 24, 26 and 29-33. The Final Office Action's rejections based on 35 U.S.C. §103 fail to establish a prima facie case of obviousness. The Final Office Action is incomprehensible. The Final Office Action fails to articulate any plausible reasons supported by some rationale underpinning why a person of ordinary skill in the art would combine the references and arrive at the presently claimed subject matter. The failings of the Final Office Action are evident by the failure to address each of the limitations of claim 22. Thus, in view of each of the arguments and remarks above, Appellants respectfully request reversal of the rejections of the claims.

Respectfully submitted,

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Date: June 8, 2009

**VIII – Claims Appendix**

1-21. (Canceled)

22. An integral plastic and metal part comprising:  
a metal component having a closed cross section defining an interior and exterior and having a first opening defining edges and a second opening opposite said first opening for allowing a core tool to be inserted into said interior of said metal component during a molding operation; and

a plastic component disposed about at least a portion of said exterior of said metal component, a portion of said plastic material disposed through said first opening and including a flange extending beyond said edges of said first opening and into said interior of said metal component for securing said plastic component to said metal component, said plastic component not covering said second opening;

wherein said plastic component includes at least one integrally formed connection member extending outwardly therefrom, said at least one connection member having an area defining at least one connection portion formed therein, wherein said at least one connection portion is operable to receive a fastening member so as to permit said plastic component to be fastened to at least one other component.

23. (Canceled)

24. A part as set forth in claim 22 wherein said flange is rectangular.

25. (Canceled)

26. A part as set forth in claim 22 wherein said plastic part includes ribs.

27-28. (Canceled)

29. A part as set forth in claim 22 wherein said edge of said first opening is curved.

30. A part as set forth in claim 29 wherein said flange extends beyond said curved edge of said first opening.

31. A part as set forth in claim 22 wherein said second opening is defined by a second edge in said metal component, said second edge being folded.

32. A part as set forth in claim 22 wherein said plastic part includes attachment holes therethrough.

33. A part as set forth in claim 22 wherein said first opening comprises a series of openings.

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**X. EVIDENCE APPENDIX**

None

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**X. RELATED PROCEEDINGS APPENDIX**

None